

Remarks

This paper is responsive to the Office Action mailed March 8, 2010, setting an initial due date of June 8, 2010. This paper is timely filed.

Claims 1-6 and 27-62 are currently pending and claims 27-29 stand as withdrawn. In the Action, the Office rejected claims 1, 6, 30-32, 36-38, 47, 48, 51, 52, and 59-62 under 35 U.S.C. § 102(b) and stated that claims 2-5, 33-35, 39-46, 49-50, and 53-58 are not fairly taught by prior art.

Claim Rejection – 35 U.S.C. § 102(b)

The Office has rejected claims 1, 6, 30-32, 36-38, 47, 48, 51, 52, and 59-62 under 35 U.S.C. § 102(b) as being anticipated by Sokoll *et al.* (WO 98/28357). Applicant respectfully traverses the rejection as follows.

First, claims 6, 36-38, 47-48, 51-52, and 59-62 depend from claims the Office has stated “are not fairly taught by the prior art.” Office Action mailed March 8, 2010, page 3, first full paragraph. It is unclear to the Applicant how the Office has rejected claims as anticipated by Sokoll that depend from claims not fairly taught by the prior art. For example, claim 6 depends from claim 2 which is not taught by the prior art according to the Office. Since a dependant claim necessarily adds an element or limitation to the claim from which it depends, it is unclear how a claim that depends from a presumably allowable claim can be rejected as being anticipated. Applicant respectfully submits that the rejection of claims 6, 36-38, 47-48, 51-52, and 59-62 is improper and requests withdrawal of the rejection.

Furthermore, Applicant respectfully submits that the Office Action failed to establish how “each and every one” of the claimed features in claims 1 and 30-32 is believed to be disclosed by Sokoll. In the Office Action, the abstract of Sokoll appears to be “cut and pasted” onto pages 2 and 3 of the Office Action with a brief parenthetical appended to the end of the paragraph. The parenthetical mere cites “(abstract only)” from Sokoll. However, no reasoning is provided explaining why the citation from Sokoll is believed to disclose the claimed features, nor

is the citation matched to the features of the claims. Applicant respectfully submits that the rejection is improper at least in view of the following.

MPEP § 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)” (emphasis added). “‘The identical invention must be shown in as **complete detail** as is contained in the ... claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)” (emphasis added). Moreover, “[c]very element of the claimed invention must be literally present, **arranged as in the claim.**” *Id.* (emphasis added). In the present case, the Office Action has not established that each element of the claims is disclosed in Sokoll. The Office Action merely appended a citation to the end of a paragraph cut and pasted from the reference with no reasoning or association with the claimed features. As such, Applicant cannot reasonably determine which “element” of the claim is believed to correspond with the cited abstract in the rejection. In other words, Applicant is not put on notice as to the rationale behind the rejection and cannot adequately determine whether such basis is proper.

Further, failure to specifically identify which features of Sokoll are believed to disclose each element of the claims likely renders the Office Action “arbitrary and capricious,” and therefore invalid, under the Administrative Procedure Act (5 U.S.C. § 706), a standard to which all Actions by the USPTO must adhere (see *Dickenson v. Zurko*, 527 U.S. 150 (1999)). Without proper guidance as to which “element” of the claim is believed to correspond with which section cited in the rejection, Applicant is forced to guess which features in the cited art the Examiner believed to disclose each of the claimed features.

Because reasons for the rejection were not presented in the Office Action and Applicant cannot reasonably determine which feature of Sokoll is believed to correspond with which feature recited in the claims, it is respectfully submitted that the rejection is improper and must be withdrawn.

The Office is encouraged to contact the undersigned at the telephone number listed below to discuss any questions it may have regarding the instant application and response.

It is believed that there is no fee or no additional fee associated with the filing and consideration of this document; however, should the Commissioner decide that any fee or fee deficiency is due, the Commissioner is hereby authorized to charge any and all fees incurred as a result of entering or considering this document to deposit account number 03-0172.

Respectfully submitted,

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